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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616

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TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
SUITE 100  
HOUSTON, TX 77024

EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 12-18 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 12-18 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 12-18 and 21-24 is withdrawn in view of the newly discovered references to Hazra et al. (U.S. Pat. #: 5,787,154), Longo et al. (U.S. Pat. #: 5,912,956) and Malik (U.S. Pat. #: 5,903,636). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 12-17 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hazra et al. (U.S. Pat. #: 5,787,154).

Regarding claims 12 and 25, Hazra et al. ("Hazra") teaches an apparatus, such as an universal authentication (AU) device, and a method for use in making a communication from a first communication device such as calling telephone terminal (i.e., caller telephone terminal such as payphone or his/her own telephone) to a second communication device such as authentication system including a network switch/PBX or a gatekeeper coupled to a communication network, as shown in figure 6 (col.8, lines 5-25). The AU device comprises a memory having recorded therein, a substantially unique identifying value for use in authenticating usage of the AU device (i.e., PIN for a limited

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number of times and a limited amount of time). The memory of AU device also has a preprogrammed custom ID message (i.e., sequence id of the AU device) for delivery to the second communication device (authentication system) upon authenticated usage of the apparatus; and provides a preprogrammed custom ID message for delivery to the second communication device upon authenticated usage of the apparatus (i.e., the sequence id of the AU device imbedded in an encoded 16-digits output to be transmitted to the authentication system, col.7, lines 16-63).

Regarding claims 13 and 26, note col.7, line 55 – col.8, line 4.

Regarding claim 14, note col.2, lines 31-38 and col.3, lines 27-41, note figure 5.

Regarding claim 15, note col.2, lines 59-61, col.6, lines 47-48 and col.9, lines 42-49.

Regarding claims 16-17, note col.2, lines 31-38, col.3, lines 27-41 and col.5, lines 35-48, note figure 5.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazra et al. (U.S. Pat. #: 5,787,154) in view of Malik (U.S. Pat. #: 5,903,636).

Regarding claim 21, Hazra teaches all limitations of the claim in the rejection of claims 12 and 21 above. Hazra further teaches the feature of transmitting encoded private information such as credit card number via the gatekeeper to called party (col.8, lines 25-58). Hazra fails to clearly teach such private information is used as a predetermined message for substitution in place of the respective caller ID value of a telephone (i.e., payphone) at which the apparatus is used to make the call; and said the apparatus is a calling card. However, Malik teaches such features in col.7, line 23 – col.8, line 32 for a purpose of allowing caller to make call from a payphone and providing his or her caller ID to called party terminal.

Therefore, it would have been obvious one of ordinary skill in the art at the time the invention was made to incorporate the use of substitution of the predetermined message in place of the respective caller ID value of the payphone, as taught by Malik, in view of Hazra in order to provide caller ID information to called party terminal even if a call is made from a public phone.

Regarding claim 22, Malik further teaches limitations of the claims in col.7, lines 43-50.

Regarding claim 23, Hazra further teaches limitations of the claim in col.7, line 55 – col.8, line 4.

Regarding claim 24, Hazra further teaches limitations of the claim in col.2, lines 59-61, col.6, lines 47-48 and col.9, lines 42-49.

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6. Claims 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazra et al. (U.S. Pat. #: 5,787,154) in view of Longo et al. (U.S. Pat. #: 5,912,956).

Regarding claims 18 and 27, Hazra teaches all subject matters as claimed above, except for a feature of providing a plurality of preprogrammed custom ID messages on said apparatus. However, Longo et al. ("Longo") teaches an identification tag as shown in figure 3 comprising a plurality of preprogrammed custom ID messages for finder or caller to select (col.4, lines 1-44) for a purpose of reaching the respective destination terminal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of providing a plurality of preprogrammed custom ID messages on said identification tag, as taught by Longo, in view of Hazra in order to improve on the manner of making calls for specific request service(s) from the AU device.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

Any response to this action should be mailed to:

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Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

  
BINH TIEU  
PRIMARY EXAMINER